

REMARKS/ARGUMENTS

Favorable consideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-13 are pending in the present application and Claims 1, 2, 6-9, 12 and 13 are amended by the present response. Claims 14-26 are previously withdrawn. Support for amendments to the claims is found in the disclosure as originally filed. Thus, no new matter is added.

In the outstanding Action, the specification was objected to as including informalities; Claims 6-13 were rejected under 35 U.S.C. §101 as directed to non-statutory subject matter; Claims 1-13 were rejected under 35 U.S.C. §112, second paragraph as indefinite; and Claims 1-13 were rejected under 35 U.S.C. §103(a) as unpatentable over Higashi et al. (U.S. Pat. Pub. No. 2004/0249759).

Initially, Applicants and Applicants' representatives wish to thank Supervisory Examiner Fischer for the interview with Applicants' representatives on July 1, 2009. During the interview the present invention and differences between the invention and the references in the outstanding Office Action were discussed in detail. Comments and similar claim amendments discussed during the interview are reiterated below.

With respect to the rejection of Claims 6-13 under 35 U.S.C. §101 as directed to non-statutory subject matter, Applicants respectfully submit that Claims 6, 7, 12 and 13 have been amended to overcome the rejection. Specifically, Claims 6 and 12 have been amended to tie the method steps to the positively recited information-processing apparatus and Claims 7 and 13 have been amended to recite computer readable medium claims in a form which matches the suggested form provided in the outstanding Action. Accordingly, Applicants respectfully request that the rejection of Claims 6-13 under 35 U.S.C. §101, as directed to non-statutory subject matter, be withdrawn.

With regard to the objection to the specification as failing to provide proper antecedent basis for the claimed subject matter, Applicants respectfully traverse this objection. Specifically, Applicants note that each of the elements listed in items a-n on pages 2-3 appears in the originally filed claims. As such, this language is, by virtue of its existence in the original claims, already part of the originally filed specification.

The Advisory Action of August 7, 2009 states that the objection to the specification is maintained. However, *Applicants note that the terms listed in items a-n on pages 2-3 of the outstanding Action also appear in the originally filed specification, at least, on pages 2-29.* Thus, as was agreed in the interview of July 1, 2009<sup>1</sup> proper antecedent basis for the claimed subject matter is found in the originally filed disclosure.

Accordingly, as a result, Applicants respectfully submit that the objection to the specification is improper and respectfully request that the objection be withdrawn.

With respect to the rejection of Claims 1-13 under 35 U.S.C. §112 second paragraph as indefinite, Applicant respectfully submit that Claims 1-9 and 13 have been amended to overcome the issues noted in items 21 and 22 on page 9.

With regard to the §112 second paragraph rejections indicated in items 17 and 18 on pages 6-8, Applicants respectfully traverse these rejections as improper.

With regard to item 17, although Applicants believe that the term “electronic point count” would be clear to one of ordinary skill in the art; Applicants have amended the claims to define the term electronic points in the claims by reciting that the electronic points are for purchasing the predetermined contents. Thus, as was discussed in the interview, the term “electronic point” is now sufficiently defined in the claim.

With regard to item 18, the outstanding Action cites In re Morris 44 USPQ 2d at 1029, as providing support for the position that Applicants have a burden to specifically

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<sup>1</sup> In the interview of July 1, 2009 Examiner Fischer agreed that if the terms noted in the objection to the specification were included in the summary of the invention section, sufficient antecedent basis would exist.

identify the corresponding structure for each means element recited in the claims, Applicants respectfully this assertion and submit that this case does not provide this burden.

However, Applicants note that there is a burden that exists in the case; specifically, the Office has a burden to provide a prima facie case of lack of written description.

As is noted in *In re Alton*, 76 F.3d 1168, 1175 (Fed. Cir. 1996),

The examiner (or the Board, if the Board is the first body to raise a particular ground for rejection) "bears the initial burden ... of presenting a prima facie case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed.Cir.1992). Insofar as the written description requirement is concerned, that burden is discharged by "presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims." *Wertheim*, 541 F.2d at 263, 191 USPQ at 97. Thus, the burden placed on the examiner varies, depending upon what the applicant claims. If the applicant claims embodiments of the invention that are completely outside the scope of the specification, then the examiner or Board need only establish this fact to make out a prima facie case. *Id.* at 263-64, 191 USPQ at 97. If, on the other hand, the specification contains a description of the claimed invention, albeit not in *ipsis verbis* (in the identical words), then the examiner or Board, in order to meet the burden of proof, **must provide reasons why one of ordinary skill in the art would not consider the description sufficient.** *Id.* at 264, 191 USPQ at 98. (emphasis added).

In the present case, the outstanding Action has provided no reasoning regarding why "the written description fails to disclose the corresponding structure, material, or acts for the claimed function." In fact a cursory view of the disclosure would clearly evidence that support for the claimed features is found in the disclosure. For example, "a utilization-condition storage means for storing said utilization condition and said table" is clearly described in Figures 9 & 10 and corresponding disclosure. For instance, on page 42 the disclosure states "...a hard disk 74 is used for storing also the sales-history table 21A...in addition, the hard disk 74 is used also for storing a necessary utilization condition."

Thus, Applicants respectfully submit that the outstanding Action has not met its burden of providing a *prima facie* case that the written description fails to disclose the corresponding structure, material, or acts for the recited means claims.

Accordingly, Applicants respectfully request that the rejections under 35 U.S.C. §112, second paragraph be withdrawn in light of the above discussion.

Addressing now the rejection of Claims 1-13 under 35 U.S.C. §103(a) as unpatentable over Higashi, Applicants respectfully traverse this rejection.

Claim 1 recites, in part

A content-providing system comprising a terminal for utilizing contents and a server connected to said terminal through a network and used for managing said contents comprising:

said terminal including

storage means for storing said contents in advance;

request means for requesting utilization of predetermined contents by transmitting content IDs identifying said predetermined contents among a plurality of said contents stored in said storage means and by transmitting an electronic points purchase request, the electronic points for purchasing said predetermined contents, to said server;

reception means for receiving both a table associating said content IDs with an electronic point amount, and a utilization condition each transmitted by said server in response to said request by said request means, said utilization condition including an available electronic point amount determined based on the points purchase request;

utilization-condition storage means for storing said utilization condition and said table, which are received by said reception means, said utilization-condition storage means being further a means for updating said table on the basis of a content ID and an update of said electronic point amount, which are received from said server; and

utilization execution means for executing utilization of said predetermined contents on the basis of said utilization condition and said table, which have been stored in said utilization-condition storage means;

said server including

utilization-condition transmission means for transmitting said table associating said content IDs with said electronic point amount and for transmitting said utilization condition, to said terminal;

sales-history information storage means for storing sales-history information of said predetermined contents pertaining to a range as information including said content IDs identifying said predetermined contents, utilization of which is requested by said request means employed in said terminal;

collection means for collecting sales records of contents utilized by said terminal on the basis of said sales-history information stored in said sales-history information storage means; and

processing execution means for carrying out processing based on said sales records, wherein said utilization-condition transmission means, employed in said server, is further a means for transmitting a content ID and an update of said electronic point amount.

Claims 2, 6 and 7 recite apparatus, method and medium claims corresponding to the server portion of the claim and Claims 8, 12 and 13 recite apparatus, method and medium claims corresponding to the terminal portion of the claim.

Higashi describes a content providing apparatus the uses a license to grant content use to a user.

However, Higashi does not describe or suggest a utilization-condition storage means for storing said utilization condition and said table, which are received by said reception means, said utilization-condition storage means being further a means for updating said table on the basis of a content ID and an update of said electronic point amount, which are received from said server.

As was discussed in the interview, the claimed invention describes that the “price” or the amount of electronic points required to “purchase” a particular piece of content is governed by the utilization condition and said table stored locally on the terminal. Moreover, the utilization-condition storage means updates the table on the basis of a content ID and an update of said electronic point amount which are received from said server. Thus, the claimed invention is able to update the “price” of the content by updating the table stored on the terminal. This feature is not described or suggested in Higashi.

Thus, while the claimed invention is able to update the table stored on the terminal which the execution of the content is based upon, Higashi never describes such a feature.

Accordingly, Applicants respectfully request that the rejection of Claims 1-13 under 35 U.S.C. §103(a) as unpatentable over Higashi be withdrawn.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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